

REMARKS

The Examiner rejected claims 1, 4, 5, 12-33 and 36 under 35 USC 102(b) as being anticipated by Anderson et al. (US Patent 4,685,234). The Examiner also rejected claims 1, 4, 19-21, 28 and 46-48 under 35 USC 102(b) as being anticipated by Damvig (US Patent 4,745,664). The Examiner also rejected claims 1, 4, 6, 7, 9 and 19-21 under 35 USC 102(b) as being anticipated by Hogan et al. (US Patent 5,140,836). The Examiner also rejected claims 6-11, 34, 35 and 37-45 under 35 USC 103(a) as being unpatentable over Anderson et al. in view of Hogan et al. The Examiner also rejected claims 6-11, 37 and 38 under 35 USC 103(a) as being unpatentable over Damvig in view of Hogan et al. The Examiner also rejected claims 2 and 3 under 35 USC 103(a) as being unpatentable over Damvig in view of Mazzucchelli (US Patent 5,791,079).

Applicant submits that the present invention is substantially different and patentably distinct from the cited references. Tag 10 of Applicant's invention includes a first tag element 20 and a second tag element 22 which are configured to lock together so that an item of merchandise 14 cannot be removed from the tag 10 and/or from a retail establishment without triggering an alarm. More particularly, first tag element 20 carries a first locking member 32 and second tag element 22 carries a second locking member 36 which is lockably engaged by first locking member 32 in a locked position. First locking member 32 is slidably mounted on a pair of spaced ribs 28 of first tab element 20 and second pair of spaced ribs 30 of first tag element 20. Each of ribs 28 and 30 are elongated and substantially parallel to one another. In particular, second locking member 32 is slidably mounted on said ribs 28 and 30 along opposed edges of first locking member 32. First locking member 32 includes a pair of opposed teeth 54 which are elongated and parallel to one another and thereby define an elongated slot 50 therebetween. Teeth 54 also define an opening 52 which has a cross-sectional dimension which is larger than the cross-sectional dimension of slot 50.

First locking member 32 is moveable between a locked position in which first locking member lockingly engages second locking member 36 and an unlocked position in which second locking member 36 is removable from first locking member 32. More particularly, first locking member 32 is slidably moveable between the locked and unlocked positions. Even more particularly, first locking member 32 is slidable in a single linear direction which is parallel to ribs 28 and 30 and also parallel to slot 50 of first locking member 32. Preferably, first locking member 32 has a V-shaped cross-sectional configuration wherein slot 50 is defined at the bottom of the V. Slot 50 is open ended on one end and closed on the opposed end adjacent a rigid portion of second locking member 32 which extends between the opposed teeth 54. This portion extending between opposed teeth 54 is rigid and situated along the bottom of the V of the V-shaped first locking member 32.

The second locking member 36 of the present invention is carried by second tag element 22. In particular, second tag element 22 includes a second locking member 36 in the form of a stepped post and a generally circular head whereby the head and second locking member 36 form a tack. The post of second locking member 36 includes a plurality of steps 62 such that alternating portions of the posts have larger and smaller cross-sectional dimensions. When second locking member 36 is in the locked position, teeth 54 of first locking member 32 are closely adjacent or abut the smaller cross-sectional dimensions of the post and steps 62 add to the difficulty in removing second locking member 36 from first locking member 32. The post of second locking member 36 is elongated along an axis along which second locking member 36 is moveable during connection and disconnection of the first and second locking members. First locking member 32 is slidably moveable in a single linear direction, and in particular, a direction which is perpendicular to the axis of second locking member 36.

In locking first and second locking members 32 and 36 together, the post of second locking member 36 is moved along the aforementioned axis through a hole defined in first tag element 20 and through slot 50 of first locking member 32. During this movement of second locking member 36, a portion of the post of second

locking member 36 is forced between opposed teeth 54 so that opposed teeth 54 flexingly spread away from one another to allow at least one of the larger cross-sectional dimension portions of the post to pass beyond teeth 54 so that one of the smaller cross-sectional dimension portions of the post is disposed between teeth 54 in the locked position whereby one of steps 62 of second locking member 36 prevents removal of second locking member 36 from first locking member 32. Once the smaller cross-sectional dimension portions of the post of second locking member 36 is disposed between teeth 54 of first locking member 32, first locking member 32 has returned to its original position, the opposed teeth 54 having flexed back toward one another.

To unlock the tag of the present invention, first locking member 32 is slid in a manner as described above so that the post of second locking member 36 is disposed in opening 52 which is larger than the cross-sectional dimension of the larger portion of the post of second locking member 36 whereby second locking member 36 may be withdrawn from first locking member 32. The sliding movement of first locking member 32 occurs without spreading opposed teeth 54 away from one another and without changing the spacing between the opposed teeth 54. Thus, no flexing of first locking member 32 occurs as it is slid from the locked to the unlocked position. Once in the unlocked position, second locking member 36 may also be removed from first locking member 32 without spreading opposed teeth 54 apart from one another or changing the spacing therebetween.

The unlocking of tag 10 in particular is done by the insertion of a key probe 42, which directly engages first locking member 32 to cause it to linearly slide as described above from the locked to the unlocked position. Key prong 42 moves substantially in the same linear direction as first locking member 32. More particularly, key prong 42 breaks seal 44 which had covered an interior chamber of first tag element 20 in which first locking member 32 is disposed. Seal 44 is relatively thin and is substantially thinner than the other walls of first tag element 20 to allow key prong 42 to break seal 44. Once key prong 42 breaks seal 44, key

prong 42 is able to directly contact first locking member 32 to move from the locked to the unlocked positions without key prong 42 contacting elongated ribs 28 or 30.

The Examiner objected to an informality in line 11 of claim 37, in particular indicating that "the first locking element" had no antecedent basis and should be changed to "the first locking member". Applicant has made such change to overcome the objection.

In establishing a prima facie case of anticipation under 35 USC § 102, the Examiner must find every element of the applicant's claim in a single reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Other references may be used only to interpret the allegedly anticipated reference. Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc., 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984). This idea was similarly upheld in Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F. 2d. 1565, 18 USPQ2d. 1896 (Fed. Cir. 1991), wherein the Court held that, "Invalidity for anticipation requires that all of the elements and limitations of the claims are found within a single prior art reference."

The Examiner rejected claims 1, 4, 5, 12-33 and 36 under 35 USC 102(b) as being anticipated by Anderson et al. (US Patent 4,685,234). In light of the discussion above, it is clear that Applicant's invention is substantially different than that of Anderson et al. In particular, Anderson et al. teaches a first locking member in the form of a pair of latching chocks 26 which move away from one another to allow removal of the first locking member 22 therefrom. Latching chocks 26 move toward one another in order to create a locking engagement with first locking member 22 of Anderson et al. By contrast, Applicant's first locking member 32 is a one-piece member which functions in a completely different manner, as described above. The latching chocks 26 of Anderson are spring-biased into the locked position by a spring element 28 and require the use of the camming engagement between chocks 26 and the first tag element 14 in order to move from the unlocked position wherein chocks 26 are spaced from one another to the locked position wherein chocks 26 are closely adjacent one another to engage second locking

member 22. Thus, chocks 26 are moveable in a direction which is parallel to the post or second locking member 22 as well as in a direction outwardly from the post or the axis along which the post moves. In particular, when the spring bias to the locked position is overcome, chocks 26 then are allowed to move along the axis along which post 22 is also moveable and additionally in a direction transverse to that axis in order for the chocks to move apart from one another to release the second locking member 22. When spring 28 is then allowed to bias chocks 26 toward the locked position, chocks 26 move again along the axis and then also inwardly toward the second locking member 22 in a direction which is transverse to the axis in accordance with the above-noted camming engagement.

With regard to claim 1, Applicant has amended the claim to include that the first locking member is a one-piece member. This in itself defines over Anderson et al., which requires that the first locking member is in the form of a pair of latching chocks 26. The Anderson et al. locking mechanism would not function if the first locking member were only one piece. Applicant submits that claim 1 is therefore allowable in light of this portion of the amendment to claim 1. In addition, claim 1 has been amended to indicate that the first locking member is free of a camming engagement with the first tag element for moving the first locking member from the unlocked to the locked position. This also defines over Anderson et al., which requires a camming engagement between the first locking member and the first tag element in order to move the first locking member, ie. latching chocks 26 toward one another from the unlocked position to the locked position in order to lockingly engage post 22. Applicant thus submits that claim 1 is allowable for each of these reasons and that claims 4, 5 and 12-28 are allowable as depending from an allowable claim.

With further regard to claim 22, Applicant submits that Anderson et al. fails to teach or suggest a portion of the first locking member extending between and being rigidly mounted on opposed teeth of the first locking member wherein the portion is rigid. Anderson et al. teach away from this limitation, as the opposed teeth of Anderson are necessarily located respectively on the pair of latching chocks

26 and because latching chocks 26 are in the form of two pieces which are moveable away from and toward one another, there can be no such rigid portion of the first locking member which is rigidly mounted on each of these opposed teeth. Applicant therefore submits that claim 22 is allowable in its own right.

With further regard to claim 23, Applicant submits that Anderson et al. teach away from the limitation of the slot having a closed end and that the closed end is formed by the portion of the first locking member which is rigidly on the teeth. Due to the two-piece nature of the Anderson et al. first locking member 26, the slot defined therebetween is necessarily open on both ends so that it is impossible for the Anderson et al. first locking member to teach a closed end or that that end is formed by the rigid portion which is rigidly mounted on the teeth. Therefore, Applicant submits that claim 23 is allowable in its own right.

With further regard to claim 27, Applicant submits that Anderson et al. failed to teach or suggest a first locking member having opposed teeth defining a slot wherein the first locking member slides from the locked position to the unlocked position without changing the spacing between the teeth. In order for the Anderson et al. invention to function, the spacing between the opposed teeth must change when the first locking member moves from the locked position to the unlocked position in order for the post 22 of Anderson et al. to be released. Therefore, Applicant submits that Anderson et al. teaches away from this limitation and that claim 27 is independently allowable.

With further regard to independent claim 29, Applicant has amended the claim to indicate that the second locking member is removable from the first locking member without spreading the opposed teeth away from each other. As discussed above, Anderson et al. teaches opposed teeth each of which are on separate latching chocks 26. Said opposed teeth must spread or move away from each other in order for the second locking key member to be removable from the first locking member. The Anderson et al. invention would not otherwise function. Thus, Applicant submits that claim 29 as amended is allowable and that claims 30-33 and 36 are allowable as depending from an allowable claim. Applicant also notes that

claim 29 has been amended to correct an inadvertent antecedent issue with regard to the locked position.

With further regard to claim 33, Applicant submits that Anderson et al. teach away from a portion of the first locking member extending between and being rigidly mounted on the teeth wherein said portion is rigid, as discussed with regard to claim 22 above. The rationale with regard to claim 22 is incorporated herein and Applicant submits that claim 33 is therefore allowable in its own right.

With further regard to claim 36, Applicant submits that Anderson et al. failed to teach that the first locking member moves in a direction substantially perpendicular to the longitudinal axis of the second locking member when the first locking member moves from the locked position to the unlocked position. The latching chocks 26 of Anderson et al. when moving from the locked to the unlocked position would predominantly move substantially parallel to the longitudinal axis of the second locking member as the biasing force of spring 28 is removed to allow latching chocks 26 to move toward spring 28. Additional movement of latching chocks 26 is primarily directed by the camming surfaces which allow latching chocks 26 to move outwardly from post 22 on an angle of about 45° to the axis. However, this direction would not be perpendicular to the longitudinal axis of the second locking member. Applicant thus submits that claim 36 is allowable in its own right.

The Examiner also rejected claims 1, 4, 19-21, 28 and 46-48 under 35 USC 102(b) as being anticipated by Damvig (US Patent 4,745,664). Damvig teaches a theft deterrent tag having a first tag element 3, 4, 5 and 6 and a second tag element 1. The first tag element houses a first locking member 8 which is moveable within cavity 7 defined by the first tag element. Second tag element 1 includes a post which is lockably engaged by first locking member 8 in order to lock the first and tag elements together. First locking member 8 is spring biased by a spring element 11 toward a locked position. First locking member is not connected to anything and is, aside from this spring bias, freely moveable within cavity 7 when in an unlocked position. The post of second locking member 1 is inserted through a hole in the first tag element so that first locking member 8 can lockingly engage the second

locking member 1 within cavity 7. There is a camming engagement between first locking member 8 and portion 5 of the first tag element so that when spring element 11 pushes first locking member 8 toward the locked position, the camming engagement moves first locking member 8 toward the post of second locking member 1 whereby the post is clamped between a projection 10 of first locking member 8 and a hard metal wall 15 of the first tag element. Preferably, the post has a narrow portion 2 whereby projection 10 of first locking member 8 engages narrowed portion 2 and/or a step adjacent portion 2 to assist in preventing the removal of the post of second locking member 1 when first locking member 8 is in the locked position.

With regard to claim 1 and as noted above, claim 1 has been amended to indicate that the first locking member is free of the camming engagement with the first tag element for moving the first locking member from the unlocked position to the locked position. Applicant submits that Damvig requires a camming engagement for this purpose. Without such a camming engagement, second locking member 8 of Damvig would not form a locking engagement with the post of the second locking member 1. Thus, Damvig teaches away from this limitation and Applicant submits that claim 1 is therefore allowable and that claims 4, 19-21 and 28 are allowable as depending from claim 1. A second embodiment of Damvig includes a first locking member which is in the form of two pieces (Fig. 4). In keeping with the first embodiment of Damvig, the second embodiment includes a spring bias via spring elements 11 of the first locking member to the locked position. In addition, the two pieces require a camming engagement in order for the two-piece first locking member to lockingly engage the second locking member 1. With regard to this embodiment, Applicant submits that claim 1 is additionally allowable due to the limitation of the first locking member being a one-piece member.

With regard to independent claim 46, Applicant submits that Damvig fails to teach or suggest that the first tag element includes opposed ribs that are elongated and spaced from one another to define a portion of an opening sized to received a key prong that moves the first locking member from the locked position to the

unlocked position wherein the key prong directly engages the first locking member without engaging the ribs of the first tag element when the key prong is moving the first locking member from the locked position to the unlocked position.

Applicant submits that claim 46 in its original form defined over Damvig. However, Applicant has amended the claim to indicate that the opposed ribs are elongated and spaced from one another to clarify the configuration of Applicant's invention. While Damvig does teach a key prong (Fig. 3) for directly contacting the first locking member to move from the locked to the unlocked position, Damvig fails to teach the opposed ribs of the first tag element as claimed by Applicant. Fig. 3 fails to teach or suggest such opposed ribs which are elongated and spaced from one another and partially define an opening through which the key prong is received and Damvig's description likewise fails to teach or suggest this limitation. (See Column 4, lines 15-22). If anything, the referenced portion of Damvig indicates that the openings in the first tag element should be as discreet as possible, thus suggesting that the key prong would not be able to engage the first locking member without engaging ribs or some other portion of the first tag element. Therefore, Applicant submits that independent claim 46 is allowable and that claims 47 and 48 are allowable as depending therefrom.

With further regard to claim 48, Applicant submits that Damvig fails to teach first and second halves which cooperate together to define the opening adapted to receive the key prong. To the contrary, the best that can be gleaned from the Damvig disclosure is that the key prong would simply extend through a hole formed in the first tag element wherein the hole would be defined by only one of the halves of the first tag element that are joined to form the first tag element housing the first locking member. By contrast, the first half of the first tag element bounds a portion of the opening and the second half of the first tag element bounds the remaining portion of the opening so that they are cooperating together to define the opening. If the first half 3 and second half 4 of Damvig were to cooperate to define an opening through which the key prong is received, the key prong would thus necessarily enter from an angle which would not be suitable for moving the first

locking member to the unlocked position, as such an opening would have to come from the side of the first tag element as opposed to the top as shown in Fig. 3 in Damvig. Applicant therefore submits that claim 48 is allowable in its own right.

The Examiner also rejected claims 1, 4, 6, 7, 9 and 19-21 under 35 USC 102(b) as being anticipated by Hogan et al. (US Patent 5,140,836). Hogan et al. teach several embodiments of a theft deterrent device, the first embodiment being shown in Figs. 1-3b, the second embodiment being shown in Figs. 4a and 4b and the third embodiment being shown in Figs. 5a and 5b. The device of Hogan et al. includes a first tag element 12 (first embodiment) which houses a pair of first locking members 30 and 32 and a second tag element 10 which has a U-shape and includes a pair of locking members 14 and 16 each having a shelf 18 thereon which are respectively engaged by teeth 34 of member 30 and teeth 36 of member 32. The set of teeth 34 on member 30 and the set of teeth 36 on member 32 each extend generally outwardly in opposite directions from one another, unlike the opposed teeth of Applicant's invention which define a slot therebetween. Each of first locking members 30 and 32 involve camming surfaces which are used in order to move the first locking members 30 and 32 toward respective locking positions. In particular, the first embodiment includes a ball 44 which is disposed within an interior cavity of the first tag element and is in a camming engagement with camming surfaces of windows 40. First locking members 30 and 32 are spring biased by a spring element 42 into the locking position wherein teeth 34 and teeth 36 engage shelves 18 of the second locking member legs 14 and 16. In order for first locking members 30 and 32 to move from the locked position to the unlocked position, a magnet 48 is placed adjacent the first tag element 12 in order to attract ball 44 toward magnet 48 thereby moving the members 30 and 32 inwardly as a result of the camming engagement between ball 44 and the surfaces bounding windows 40. The second embodiment of Figs. 4a and 4b works in a similar fashion except for the camming surfaces on the first locking member 60 and 62 have a different configuration and ball 44 has been replaced by a wedge 74 having camming surfaces to create a camming engagement with the first locking members

60 and 62. In addition to the spring element 72 biasing the locking members to the locked position, an additional spring 76 is provided to bias the wedge 74 toward the locked position as well. The third embodiment works in a similar fashion except for it has camming surfaces 94 on the pair of first locking members 86 and 88 which engage with camming surfaces on wedge 98 of the first tag element.

With regard to claim 1 and as previously noted, claim 1 has been amended to indicate that the first locking piece is a one-piece member, which Applicant submits defines over Hogan et al. Hogan et al. must use the two-piece first locking member 30 and 32 in order for the invention to function properly. Applicant submits that claim 1 is also allowable for this reason and that claims 4, 6, 7, 9 and 19-21 are allowable as depending from an allowable claim.

With further regard to claim 9, Applicant notes that claim 9 has been amended to correct an error so that claim 9 indicates that the opposed ribs are carried by the first tag element as opposed to the first locking member.

Inasmuch as Applicant teaches a one-piece first locking member which is free of the camming engagement with the first tag element for moving the first locking member from the unlocked position to the locked position; that the first locking member includes opposed teeth which define a slot with a rigid portion of the first locking member extending between and being rigidly mounted on the teeth and that the rigid portion forms a closed end of the slot; that the first locking member slides from the locked position to the unlocked position without changing the spacing between the opposed teeth of the first locking member; that the second locking member is removable from the first locking member without spreading the opposed teeth away from each other; and that the first tag element includes opposed ribs that are elongated and spaced from one another to define a portion of an opening sized to received a key prong that moves first locking member from the locked position to the unlocked position wherein the key prong directly engages the first locking member without engaging the ribs of the first tag element when the key prong is moving the first locking member from the locked position to the

unlocked position; Applicant submits that the present invention is patentably distinct from the cited references.

The Examiner also rejected claims 6-11, 34, 35 and 37-45 under 35 USC 103(a) as being unpatentable over Anderson et al. in view of Hogan et al. The Examiner also rejected claims 6-11, 37 and 38 under 35 USC 103(a) as being unpatentable over Damvig in view of Hogan et al. The Examiner also rejected claims 2 and 3 under 35 USC 103(a) as being unpatentable over Damvig in view of Mazzucchelli (US Patent 5,791,079).

The Examiner initially has the burden of factually supporting a *prima facie* conclusion of obviousness, which then shifts the burden of providing evidence for arguments to the Applicant who may submit additional evidence of non-obviousness in order to overcome the Examiner's rejection. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation to combine the references, the three possible sources of which are the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP 2143.01, citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success in combining the references in order for it to be proper to combine them. MPEP 2143.02, citing In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The rationale to modify or combine prior art references may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of the ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. MPEP 2144, citing, for example In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedence that some advantage or expected beneficial result would have

been produced by their combination. MPEP 2144, citing In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983).

The Examiner rejected claims 6-11, 34, 35 and 37-45 under 35 USC 103(a) as being unpatentable over Anderson et al. in view of Hogan et al. In light of the above discussions regarding Anderson et al. and Hogan et al., Applicant submits that the amendment to claim 1 eliminates both references for the purpose of the present rejection. In particular, the claim 1 amendment requires the first locking member to be one-piece and neither of the cited references may function with a one-piece first locking member. Thus, the amendment to claim 1 defines over each of the references and Applicant thus submits that claims 6-11 are allowable as depending from allowable claim 1.

As discussed above with regard to claim 29 as amended, Anderson et al. fails to teach or suggest that the second locking member is removable from the first locking member without spreading the opposed teeth away from each other. Applicant thus submits that claims 34 and 35 are allowable as depending from allowable claim 29.

Claim 37 has been amended in part to indicate that the first locking member is a one-piece member and that the first locking member has opposed teeth. As previously noted, neither Anderson et al. nor Hogan et al. teach a first locking member which is a one-piece member and could not function with such a one-piece member. Applicant therefore submits that claim 37 is allowable for this reason. Claim 37 has also been amended to indicate that when the first locking member is in a locked position, removal of the post from the first locking member is prevented by engagement of the post by each of the opposed teeth of the first locking member. Because neither Anderson et al. nor Hogan et al. teach a one-piece first locking member, they cannot possibly teach such a locking member having opposed teeth nor the engagement of the post of the second locking member by each of the opposed teeth of the first locking member. Applicant therefore submits that claim 37 is additionally allowable for this reason and that claims 38-39 and 41-

45 are allowable as depending from allowable claim 37. Claim 40 has been canceled.

The Examiner also rejected claims 6-11, 37 and 38 under 35 USC 103(a) as being unpatentable over Damvig in view of Hogan et al. As noted above with regard to the discussion of claim 1, claim 1 has been amended to indicate in part that the first locking member is free of the camming engagement with the first tag element for moving the first locking member from the unlocked position to the locked position. As discussed above with regard to the 102b rejection as being anticipated by Damvig, Applicant notes that Damvig teaches away from the limitation of the amendment. Thus, Applicant submits that claims 6-11 are allowable as depending from allowed claim 1.

Applicant further notes that claim 37 has been amended in part to require that the first locking member is a one-piece member having opposed teeth. Although Damvig has a one-piece first locking member, that locking member does not have opposed teeth. In addition, claim 37 has been amended to indicate that when a first locking member is in a locked position removal of the post from the first locking member is prevented by engagement of the post by each of the opposed teeth of the first locking member. Thus, not only does Damvig fail to teach a one-piece member having opposed teeth, but also such a member wherein each of the opposed teeth would engage the post of the second locking member to prevent removal thereof when in a locked position. Hogan et al. also fails to teach a one-piece first locking member or such a member having opposed teeth or the engagement of the post by each of the opposed teeth as claimed. Therefore, Applicant submits that claim 37 is allowable and that claim 38 is allowable as depending therefrom.

The Examiner also rejected claims 2 and 3 under 35 USC 103(a) as being unpatentable over Damvig in view of Mazzucchelli (US Patent 5,791,079). Applicant submits that Damvig and Mazzucchelli cannot be properly combined. Damvig teaches a theft deterrent tag which is to be repeatedly used while Mazzucchelli teaches a tag which is to be used but a single time and disposed once the

crosspiece 9a is broken. Thus, the seal or crosspiece 9a of Mazzucchelli hardly provides an advantage to the tag of Damvig, as the seal 9a or a similar structure would only be used one time whereas the Damvig tag is to be used multiple times and thus the seal would have no use subsequent to the first use. In addition, even if there were some value to a one-use seal, the breaking of such a seal would cause broken pieces to either clog the passage through which a key prong would be inserted or enter into the interior cavity 7 of the Damvig first tag element and present an interference problem with the movement of first locking member 8 and/or spring element 11, thereby defeating the use of the security tag of Damvig. Applicant thus submits that Damvig and Mazzucchelli teach away from proper combination and therefore the rejection of claims 2 and 3 should be withdrawn.

With further regard to claim 3, even if the references could be properly combined, Mazzucchelli teaches that the seal 9a is thicker than the body walls of the Mazzucchelli tag which is the opposite of claim 3. Therefore, Applicant submits that claim 3 is also allowable in its own right.

Inasmuch as Applicant teaches a one-piece first locking member which is free of a camming engagement with the first tag element for moving the first locking member from the unlocked position to the locked position; that the one-piece first locking member has opposed teeth and that the removal of the post from the first locking member is prevented by engagement of the post by each of the opposed teeth when the first locking member is in a locked position; and that the post of the second locking member has a longitudinal axis and the first locking member slides perpendicularly to the longitudinal axis when the first locking member moves from the locked to the unlocked position; Applicant submits that the tag of the present invention is patentably distinct from the cited references.

Applicant has added new claims 49-77, including new independent claims 62, 65, 67, 71 and 73, all of which Applicant submits are allowable in light of the above discussion.

With further regard to new independent claim 62, Applicant submits that the cited references fail to teach or suggest a one-piece first locking member and a

second locking member having an axis along which the second locking member is movable during connection and disconnection of the first and second tag elements whereby the first locking member is linearly movable only in a direction which is perpendicular to the axis from the locked position to the unlocked position to allow the second locking member to be released. As discussed above, the first locking member is linearly moveable only in a direction which is perpendicular to the axis as claimed. Anderson et al. and Hogan et al. both include tags which require a two-piece first locking member in order to function. Therefore, these references cannot teach or suggest a one-piece first locking member at all. While Damvig teaches a one-piece first locking member, it fails to teach or suggest that that first locking member is linearly movable only in a direction perpendicular to the axis. The Damvig first locking member 8 must move substantially in the same direction as the axis of the second locking member as claimed. In addition, the first locking member of Damvig may move in essentially any direction when the spring element 11 is not biasing it toward the locked position and when it is not engaged with second locking member 1. If the first locking member 8 of Damvig were required to move linearly only in a direction perpendicular to the axis, the Damvig tag could not possibly function.

With regard to new independent claim 65, Applicant submits that the cited references fail to teach or suggest a first locking member including opposed teeth that define a slot therebetween such that the first locking member is moveable from a locked position to an unlocked position to allow the second locking member to be released from the first locking member without spreading the opposed teeth away from each other. With regard to Anderson et al., the opposed teeth which are respectively on the pair of latching chocks 26 must be spread away from each other in order for the tag to unlock and release the second locking member 22. The two-piece first locking member of Hogan et al. fails to have opposed teeth which define a slot therebetween. In addition, Hogan et al. thus necessarily fails to teach that the second locking member includes a portion that is disposed in the slot between teeth when the first locking member is in the locked position.

With further regard to claim 67, Applicant submits that the cited references fail to teach a one-piece first locking member having opposed teeth which define a slot therebetween and that the first locking member is moveable only in a single linear direction from a locked position to an unlocked position wherein the second locking members are removable from the first locking member. The tag of Anderson et al. requires a two-piece first locking member. In addition, even if each piece of the locking member individually moves in single linear direction, each of them must move in different linear directions. With regard to Hogan et al. as noted above, Hogan also teaches a two-piece first locking member and also fails to teach that the first locking member has opposed teeth defining a slot therebetween. Damvig teaches that either a two-piece locking member or a one-piece locking member which fails to have opposed teeth defining a slot therebetween. As discussed above, Damvig also teaches that the first locking member is moveable in far more than a single linear direction.

With regard to claim 71, Applicant submits that the cited references fail to teach a one-piece first locking member which includes opposed teeth defining a slot therebetween such that first locking member is non-pivotably and non-flexingly moveable from the locked position to the unlocked position wherein the second locking member is removable from the first locking member. As noted above, Anderson et al. teaches a two-piece first locking member necessary to the function of the device. Hogan et al. also teach a two-piece locking member necessary to the function of the device and which in addition fails to include opposed teeth defining a slot therebetween. Damvig teaches either a two-piece first locking member or a one-piece first locking member which fails to have opposed teeth defining a slot therebetween and thus fails to teach a second locking member including a portion disposed in the slot between the teeth in a locked position.

With further regard to independent claim 73, Applicant submits that the cited references fail to teach first locking member which flexes to lock the first and second locking members together and that the second locking member is removable from the first locking member without flexing the first locking member.

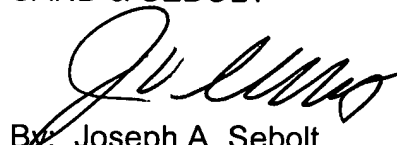
Anderson et al. teaches the two-piece first locking member wherein the two pieces spread apart and back together to lock the first and second locking members together, but they do not flex to do so. Similarly, Hogan et al. teach a first locking mechanism in two pieces each of which moves inwardly and then outwardly in order to allow locking the first and second locking members together but do not teach the flexing of the first locking member to do so. Damvig teaches two embodiments, one having a two-piece first locking member wherein each piece moves apart and together to allow the locking of the first and second locking members together without flexing of said pieces. Damvig also teaches a one-piece first locking member which moves generally downwardly against a spring element 11 in order to allow the second locking member 1 to lock to the first locking member but does not involve the flexing of the first locking member.

Applicant submits that in light of the above discussion that claims 1-39 and 41-77 are patentably distinct over the cited references and therefore allowable.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims. Please call the undersigned attorney if any questions remain after this amendment.

Respectfully submitted at Canton, Ohio this 20th day of October, 2004.

SAND & SEBOLT


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